

**Application No.:** 10/789,526  
**Filing Date.:** February 26, 2004

### **REMARKS**

Applicants have canceled claims 62 and 69 without prejudice to, or disclaimer of, the subject matter contained therein. Applicants maintain that the cancellation of a claim makes no admission as to its patentability and reserve the right to pursue the subject matter of the cancelled claim in this or any other patent application. Applicants have amended claims 1, 5-7, 13, 20-21, 46, 50, 52, 53, 56-59, 61, 68, 70 and 73. Support for these amendments can be found throughout the specification as filed, for example, page 20, lines 10-18; page 38, lines 2-4; and the original claims as filed. New claims 75-77 are added. Support for these amendments can be found throughout the specification as filed, for example, at page 17, lines 12-24 and the original claims as filed. Applicants submit that no new matter is added by these amendments and request entry of the same.

#### 35 U.S.C. § 103(a) – Obviousness

The Examiner has withdrawn the rejection of claims 46-47, 62 and 69-72 under 35 U.S.C. § 103(a) as obvious over Shoshan (WO0210449) in view of Bennett (US 6172216) and Wengel. However, claims 1, 4-7, 9, 13, 20-33, 50, 52-61, 66-68 and 73-74 remain rejected for the reasons of record. Applicants respectfully traverse.

Without acquiescing to the Examiner's rejection, and solely in the interest of advancing prosecution, Applicants have amended independent claim 1, from which all the rejected claims now depend or otherwise incorporate, to recite "wherein said compound comprises the nucleobase sequence of SEQ ID NO:19." The Examiner has stated that "compounds according to the present invention which comprise SEQ ID NO: 19 ... would be allowable." Applicants therefore respectfully request reconsideration and withdrawal of the rejection of the pending claims under 35 U.S.C. § 103(a) as obvious over Shoshan in view of Bennett and Wengel.

#### 35 U.S.C. § 112, second paragraph – Indefiniteness

Claims 46-47 and 68-73 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 46 and claims that depend therefrom are rejected because the Examiner assert that it is unclear if the ten deoxynucleotides region and are encompassed within the original

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nucleotide sequence recited in the compound of claim 1, or if these sequences are in addition to the nucleotides of the compound of claim 1.

Without acquiescing to the Examiner's rejection, and solely in the interest of advancing prosecution, Applicants have amended claim 46 to recite "wherein said antisense oligonucleotide 20 to 50 nucleobases in length comprises a ten deoxynucleotide region flanked on both the 5' end and the 3' end of said ten deoxynucleotide region with at least five 2'-O-(2-methoxyethyl) nucleotides," to clarify that the deoxynucleotide region and 5' and 3' flanking regions are encompassed within the 20 to 50 nucleobases recited in claim 1.

Claims 68 and 73 are rejected because the Examiner asserts that it is unclear which region is referred to in the claim.

Without acquiescing to the Examiner's rejection, and solely in the interest of advancing prosecution, Applicants have amended claims 68 and 73 to recite "a region of deoxynucleotides flanked on both the 5' end and the 3' end of said deoxynucleotide region with at least one 2'-O-(2-methoxyethyl) nucleotide," to clarify that the "said region" is the "deoxynucleotide region."

Claims 70-73 are rejected because the Examiner asserts that it is unclear if the ten deoxynucleotide region is added to the 5' and the 3' ends of the oligonucleotide, or if the first five nucleotides and last five nucleotides of the oligonucleotide are 2'-MOE nucleotides.

Without acquiescing to the Examiner's rejection, and solely in the interest of advancing prosecution, Applicants have amended claim 70 to recite "wherein said modified oligonucleotide consists of a ten deoxynucleotide region flanked on both the 5' end and the 3' end of said ten deoxynucleotide region with five 2'-O-(2-methoxyethyl) nucleotides," to clarify that the first and last 5 nucleotides are 2'-MOE nucleotides.

In view of the above amendments, Applicants respectfully request that the rejection of claims 46-47 and 68-73 under 35 U.S.C. § 112, second paragraph, as indefinite be withdrawn.

*Non-Statutory Obviousness-type Double Patenting*

Claims 1, 4-7, 9, 13, 20-23, 46-47, 50, 52-62, and 66-74 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims of U.S. Application No. 10/547,239, which application is the national phase of PCT/US2004/005896 filed on February 27, 2004. The instant application was filed on February 26, 2004.

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In light of the above arguments and amendments, Applicants respectfully submit that the provisional obviousness-type double patenting rejections over copending Application Serial No. 10/547,239 is the sole remaining rejection in the instant application. M.P.E.P. § 804 I.B.1. provides in relevant part:

If a “provisional” nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. *M.P.E.P. § 804 I.B.1.*

Consistent with M.P.E.P. § 804, Applicants respectfully request that the provisional obviousness-type double patenting rejection be withdrawn and the instant Application be allowed to issue.

#### No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

#### Patents/Applications

Applicants wish to draw the Examiner’s attention to the following patents/applications. Applicants encourage the Examiner to review and monitor the prosecution of the following patents/applications throughout the pendency of this application.

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Serial Number	Title	Filed
10/927,466	MODULATION OF GROWTH HORMONE RECEPTOR EXPRESSION AND INSULIN-LIKE GROWTH FACTOR EXPRESSION	08/25/2004
10/547,239	MODULATION OF GROWTH HORMONE RECEPTOR EXPRESSION AND INSULIN-LIKE GROWTH FACTOR EXPRESSION	08/25/2005

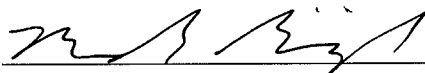
CONCLUSION

Applicants submit that the present application is in condition for allowance and respectfully requests an action to that effect. If any issues remain, the Examiner is invited to contact Applicants' counsel at the number provided below in order to resolve such issues promptly. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By:   
Brenden S. Gingrich  
Registration No. 60,295  
Attorney of Record  
Customer No. 55,389  
(619) 235-8550

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